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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,604	03/15/2001	Peter H. Markusch	Mo5944/MD-00-108-PU	4995
157	7590	03/01/2004	EXAMINER	
BAYER POLYMERS LLC 100 BAYER ROAD PITTSBURGH, PA 15205			SALVATORE, LYNDA	
			ART UNIT	PAPER NUMBER.
			1771	

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,604

Applicant(s)

MARKUSCH ET AL.

Examiner

Lynda M Salvatore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-14 and 19-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-14 and 19-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendments and accompanying remarks filed 12/10/03 have been fully considered and entered. Claims 2,19,21, and 32 have been amended as requested. Despite this advance, Applicant's amendments are not found patently distinguishable over the prior art of record and Applicant's arguments are not found persuasive of patentability for reasons set forth herein below.

Claim Rejections - 35 USC § 102/103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 2-6, 8-10 and 21 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Markusch et al., US 5,558,917 as set forth in section 4 of the last Office Action.

Applicant has amended claims 2 and 21 to recite the isocyanate formula of $(Q(NCO)_n)$ where n represents a number from 2 to about 5, Q represents an aliphatic hydrocarbon group, a cycloaliphatic hydrocarbon group, an araliphatic hydrocarbon group, or an aromatic hydrocarbon group. Applicant contends that the patent issued to Markusch et al., fails to teach the recited isocyanate formula and argues further argues that Markusch et al., is directed to a polyisocyanate blend or mixture. These arguments are not found persuasive on the grounds that 1) Markusch et al., teaches the exact formula as the set forth by the Applicant and 2) Applicant's open claim language of comprising does not preclude an isocyanate blend. With regard to the isocyanate formula, Applicant is invited to read the passage beginning in column 3, line 55,

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where it explicitly states that suitable polyisocyanates include monomeric diisocyanates represented by the formula $R(NCO)_2$. Markusch et al., teaches that R, which is the same as Applicant's "Q", represents a divalent aliphatic hydrocarbon group having 4-18 carbon atoms, a divalent cycloaliphatic hydrocarbon group having 5-15 carbon atoms, a divalent araliphatic hydrocarbon group having 7-15 carbon atoms or a divalent aromatic hydrocarbon group having 6-15 carbon atoms (Column 3, 60-Column 4, 5). In addition Markusch et al., teaches an isocyanate group content from 20-30% by weight, which meets the limitation of at least 10% by weight (Column 3, 35-45). Thus, the Examiner fails to see a difference between the instant claims and the prior art.

4. Claims 19-28 and 32 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Markusch et al., US 5,558,917 as set forth in section 10 of the last Office Action.

Applicant makes the same arguments as above. As previously stated, said arguments are not found persuasive. Thus, since no new arguments have been presented for which to consider, said claims stand rejected.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Markusch et al., US 5,558,917 as applied to claim 2 above, and further in view of Markusch et al., US 6,187,982 as set forth in section 6 of the last Office Action.

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The rejection of claim 2 over Markusch et al., 917, from which claim 7 depends stands and no new arguments have been presented.

7. Claims 12 and 13 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Markusch et al., US 5,558,917 as applied to claim 2 above, and further in view of Turner et al., US 4,853,054 as set forth in section 7 of the last Office Action.

The rejection of claim 2 over Markusch et al., 917, from which claims 12 and 13 depends stands and no new arguments have been presented.

8. Claim 14 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Markusch et al., US 5,558,917 as applied to claim 2 above for reasons set forth in section 8 of the last Office Action.

The rejection of claim 2 over Markusch et al., 917, from which claim 14 depends stands and no new arguments have been presented.

9. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Markusch et al., US 5,558,917 as applied to claim 19 above as set forth in section 12 of the last Office Action.

The rejection of claim 19 over Markusch et al., 917, from which claim 19 depends stands and no new arguments have been presented.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 571-272-1482. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1482. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 11, 2004

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